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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/242,210	11/04/1999	LINDA V GRAVELL	E-731	9775

7590 05/14/2002

CHARLES R MALANDRA JR
PITNEY BOWES INC
INTELLECTUAL PROPERTY AND TECHNOLOGY LAW DEP
35 WATERVIEW DRIVE PO BOX 3000
SHELTON, CT 06484

EXAMINER

SOUGH, HYUNG SUB

ART UNIT PAPER NUMBER

3621

DATE MAILED: 05/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/242,210

Applicant(s)

GRAVELL ET AL.

Examiner

Hyung S. Sough

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. ??.

The specification, as originally filed, does not provide support for the invention as is now claimed, i.e., “the token key used to generate a digital token” (claim 9, line 13), “the second cryptographic key further including a third key” (claim 9, lines 13-14), “using the token key to generate a digital token” (claim 14, lines 11-12), and “the first, second, third and fourth keys are identical” (claim 11).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 9, line 3, “the remote processor” does not have proper antecedent basis.

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• Claim 11, it cannot be clearly understood what “identical” means. More specifically, does “identical” mean functionally identical, structurally identical or what?

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Kara (US PAT. 5,822,739).

Kara discloses a method for evidencing postage on a mailpiece comprising the steps of:

receiving at a data center postal information relating to a mailpiece, said postal information including recipient address information for the mailpiece (col. 6, lines 34-38; col. 8, lines 24-29);

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generating a digital token for the mailpiece, said digital token including encrypted information for the mailpiece based on said recipient address information (col. 8, lines 24-29; col. 14, lines 25-67);

creating a transaction record, said transaction record including the digital the token and the postal information (col. 14, lines 29-36);

signing the transaction record (col. 14, lines 30-36; i.e., a transaction record having “a unique transaction identifier”);

storing the transaction record in a database (col. 14, lines 12-24); and

performing value added services using the transaction record (col. 14, lines 39-41).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 9-18 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Whitehouse (US PAT. 6,005,945).

Whitehouse discloses a system and method comprising a data center (102) communicatively coupled to a remote computer (104) via a network (e.g., Internet), a user initiating a request to the data center via the remote processor (110) to dispense postage value to be printed by a printer (108) coupled to the remote processor (110), the data center comprising a storage device (174) to store the user accounts (col. 8, lines 56-57) or meter accounts, and a first cryptographic module (161) coupled to the storage device (col. 12, lines 57-64) to verify the digital signature of the user. Whitehouse further discloses a second cryptographic module (164) coupled to the storage device including keys to generate a digital token (col. 8, lines 38-41 or col. 11, lines 27-29), a key to decrypt a token key included in the meter account (col. 9, lines 35-39), a transaction record (e.g., amount of transaction) and a user transaction record (e.g., second transaction table record), coordinating encryption/decryption to keep the integrity of the balance update transaction (col. 14, lines 25-28, lines 43-46), the data center sends the digital token to the remote processor via the Internet, a key management system (col. 18, line 41), on-line rating (col. 24, lines 1-11), and on-line tracking of all postal transaction processed by the data center (col. 8, lines 59-62).

Whitehouse does not explicitly disclose the use and locations of the first, second, third and fourth keys. However, Whitehouse clearly states the use of a key encryption method to secure the

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transactions and it would have been obvious to employ any number of keys as needed depending on the steps that the protection is desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate keys at any desirable modules, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Response to Arguments

9. Applicant's arguments filed on February 27, 2002 have been fully considered but they are not persuasive for the following reasons.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a key is used to sign the transaction record," "A digital signature" or "storing the signed transaction record at the data center") are not recited in the rejected claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, in col. 13, lines 41-42, Kara states that "In the case of a credit account, the user may be periodically billed for postage previously demanded." and "a unique transaction identifier" of Kara would inherently have the asserted attributes.

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10. Applicant's arguments with respect to claims 9-18 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyung S. Sough whose telephone number is (703) 308-0505. The Examiner can normally be reached Monday-Friday from 8:30 AM - 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's Supervisor, James P. Trammell, can be reached on (703) 305-9768.

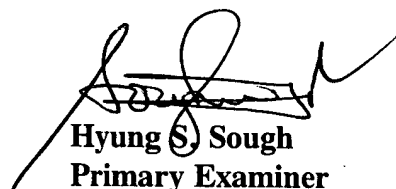
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900. The Group Fax numbers are (703) 746-7238 for After-final, (703) 746-7239 for Official, and (703) 746-7240 for Non-Official/Draft.

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shs
May 11, 2002



Hyung S. Sough
Primary Examiner
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